

## **REMARKS**

### ***Status of the Claims***

Claims 1-3, 5-18, and 34-36 are currently pending in this application and stand rejected. Applicants respectfully request entry and consideration of these amendments after final as the amendments are taken from the dependent claims and thus should require no new search.

### ***Amendments to the Claims***

Independent claim 1 is amended to include the limitations of dependent claim 36, which is hereby canceled. Claim 1 is also amended to clarify that the single cutting element is the only cutting element.

Independent claims 34 and 35 are amended to clarify that the single cutting element is the only cutting element. No new matter is added.

### ***Claim Rejections Pursuant to 35 U.S.C. §102(b)***

#### **Green**

Claims 1-3, 5, 7-12, 14-15, and 34-35 are rejected pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,409,730 of Green et al. ("Green").

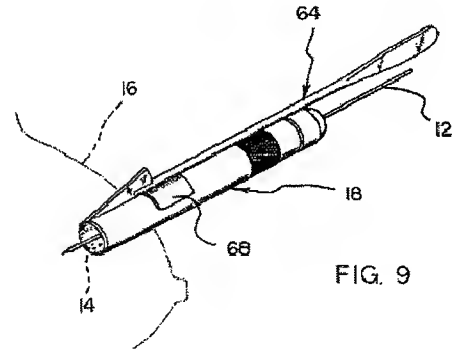
Claims 1, 34, and 35 as amended recite a tunnel notcher and guidewire delivery device having an elongate member and a cutting element disposed on the elongate member that is the *only* cutting element disposed on the elongate member. As admitted by the Examiner in the interview of June 12, 2008, Green discloses at least two cutting elements in the form of two helical blades. Thus, Green fails to meet the requirements of claims 1, 34, and 35. Accordingly, claims 1, 34, and 35 as well as claims 2, 3, 5, 7-12, 14, and 15 which depend therefrom, distinguish over Green and represent allowable subject matter.

#### **Russin**

Claims 1-3, 5, 9-15, and 36 are rejected pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,807,276 of Russin.

Claim 1 as amended requires a cutting element having a distal cutting edge disposed proximal to a distal portion of the elongate member wherein the distal portion of the elongate member has a length

greater than a length of the cutting element. Russin is directed to a device for performing a breast biopsy and teaches a cannula 18 having a scalpel 64 extending orthogonally from a distal portion of the cannula 18, as shown in FIG. 9 of Russin which is reproduced herein. The Examiner refers to the tapered distal portion of the cannula 18, near element 14, as being the claimed distal portion. Russin does not, however, meet both requirements of claim 1. Namely, Russin does not teach a cutting element with a distal cutting edge positioned proximal to a distal portion of an elongate member *and* that this distal portion of the elongate member has a length greater than a length of the cutting element.



As shown in FIG. 9, it is not clear whether or not the scalpel 64 is positioned distal to the tapered distal portion near element 14. But even if the scalpel 64 is positioned so, the tapered distal portion does not have a length greater than a length of the scalpel 64. The length of any portion of the cannula 18 that is distal to a distal cutting edge of the scalpel 64 is clearly much shorter than a length of the scalpel 64. Thus, Russin cannot anticipate claim 1 and claim 1, as well as claims 2, 3, 5, and 9-15 which depend therefrom, distinguish over Russin and represent allowable subject matter.

***Claim Rejections Pursuant to 35 U.S.C. §103(a)***

**Ruppert and Scholl**

Claims 1-3, 5-15, and 34-35 are rejected pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 571,400 of Ruppert in view of U.S. Patent No. 6,110,175 of Scholl.

At the outset, Applicants continue to believe that Ruppert is non-analogous art that is not properly combinable with Scholl for reasons previously submitted. Regardless, as noted above, claims 1, 34, and 35 are amended to recite a tunnel notcher and guidewire delivery device having an elongate member and a cutting element disposed on the elongate member that is the *only* cutting element disposed on the elongate member. Ruppert teaches a mortising chisel having multiple cutting elements disposed thereon and thus fails to meet the requirements of claims 1, 34, and 35. In addition, as admitted by the Examiner in the interview of June 12, 2008, it would not be obvious to modify the device of Rupert with the cutting element of Scholl as it would render the device of Rupert unsuitable for its intended purpose. In particular, a mortising chisel as disclosed by Rupert would fail to function as needed with only a single blade. Accordingly, claims 1, 34, and 35 as well as claims 2, 3, and 5-15

which depend therefrom, distinguish over Ruppert in view of Scholl and represent allowable subject matter.

Ruppert, Scholl, and Boucher

Claims 16-18 are rejected pursuant to 35 U.S.C. §103(a) as being obvious over Ruppert and Scholl in view of U.S. Patent No. 5,658,289 of Boucher et al. ("Boucher").

The Examiner argues that Ruppert and Scholl disclose the claimed invention except for a locking mechanism. The Examiner therefore relies on Boucher to disclose the claimed locking mechanism. As noted above, Ruppert and Scholl fail to meet the requirements of independent claim 1, and Boucher simply teaches a graft protection device that does not remedy the deficiencies of Ruppert in view of Scholl. Accordingly, claims 16-18 distinguish over Ruppert and Scholl in view of Boucher, at least because they depend from an allowable base claim.

***Conclusion***

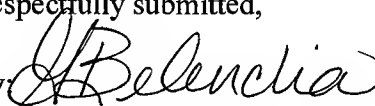
Applicants submit that all claims are in condition for allowance for at least the reasons discussed above, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

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NUTTER MCCLENNEN & FISH LLP  
155 Seaport Boulevard  
World Trade Center West  
Boston, Massachusetts 02210-2604  
(617) 439-2550  
(617) 310-9550 (Fax)

Respectfully submitted,

By

  
Giordana M. Belenchia  
Registration No.: 63,680  
Attorney for Applicant(s)